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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,883	12/15/2003	Diane Lipscombe	B0877.70026US00	6781
23628	7590	10/31/2007	EXAMINER	
WOLF GREENFIELD & SACKS, P.C. 600 ATLANTIC AVENUE BOSTON, MA 02210-2206			STANLEY, STEVEN H	
ART UNIT		PAPER NUMBER		
1649				
MAIL DATE		DELIVERY MODE		
10/31/2007		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/736,883	LIPSCOMBE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Steven H. Standley	1649	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 30 July 2007.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-4 and 37-44 is/are pending in the application.

4a) Of the above claim(s) 3,4,39,40,43 and 44 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,2,37,38,41 and 42 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/07.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

The amendment filed 7/30/07 has been made of record.

***Priority***

Priority is to the provisional application, 60/443474, filed Jan. 29, 2003.

***Rejections/Objections: Withdrawn***

***Information Disclosure Statement***

Applicant has submitted an IDS in response to the Examiner's objection to including references in the specification.

***Claim Objections***

Applicant is correct in the matter regarding the use of brackets in the claims. MPEP 714 is the appropriate guidance and the examiner has no issue with single brackets in the claims.

***Rejections/Objections: Maintained***

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2, 37-38, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan et al (Society for Neuroscience Abstract, November 2001).

Pan et al disclose the splice variant exon 37a in a human N-type calcium channel. Pan et al further disclose expression of human CaV2.2 splice variants in Xenopus Oocytes for analysis of the functional characteristics of CaV2.2 splice variants. Pan et al disclose at the end of the abstract, "Future analyses will establish the

expression patterns of exon pairs, 37a/37b...of CaV2.2 alpha1 subunit, and their effects on N-type Ca channel function." Thus, one of ordinary skill in the art would have been motivated to test the human splice variant CaV2.2e37a in a *Xenopus* Oocytes to determine the functional effect of the splice variation, and further in neurons, because that is where they are normally expressed (as disclosed in the instant Abstract). There would be quite a high expectation of success, since expressing recombinant proteins in heterologous cells such as *Xenopus* Oocytes, and in neurons, is strictly a matter of routine experimentation in the art.

Applicant argues on page 5 of Remarks that, because the specification describes the variants e37a and e37b as expressed in a "mutually exclusive manner," that Pan et al does not teach the invention.

Applicant is arguing limitations that are not in the claims. The claims are not limited exclusively to the e37a splice variant. In fact, Pan et al teach a Cav2.2 that has both e37a and e37b, contrary to applicant's assertion. Moreover, the claim language is open and "comprising," and therefore can contain anything, including the other e37 splice variant.

### Conclusion

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 1649

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Standley whose telephone number is **(571) 272-3432**. The examiner can normally be reached on Monday through Friday, 8:00 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on **(571) 272-0841**.

The fax number for the organization where this application or proceeding is assigned is **703-872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

Steve Standley, Ph.D.

10/29/07

*sd*

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